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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,328	02/26/2008	Erich M. Durrer	30887/04000	5705

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EXAMINER
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MORGAN, EMILY M

ART UNIT	PAPER NUMBER
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3677

NOTIFICATION DATE	DELIVERY MODE
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10/27/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@calfee.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/535,328	<b>Applicant(s)</b> DURRER, ERICH M.	
	<b>Examiner</b> EMILY M. MORGAN	<b>Art Unit</b> 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 4-7, 10, 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 9 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 4-7, 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/30/2010.

Examiner notes that claims 11 and 13 were initially listed as generic, which examiner regrets to admit that they were typos. Claim 11 is dependant on a nonelected claim 5, and regards a needle not present in the elected embodiment. Claim 13 also regards an insert, which is not present in the embodiment elected in figure 1.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: Applicant claims "the ear". Examiner notes that body parts are not patentable subject matter. Examiner further notes that the language present in claim 12 has similar language, but lacks confusing intended use phrases. Examiner suggests depending claims from claim 12 rather than claim 1. Appropriate correction is required.

Claim 1 is objected to because of the following informalities: Applicant claims material not present in the elected species shown in figure 1. Examiner contends that applicant should remove the phrase "or with the internal width of an insert to be put in the said recess", since examiner has properly shown that the use of the insert is another embodiment than the elected figure 1, and would result in future drawing objections if

Art Unit: 3677

not removed. Applicant should restrict all claim language to the elected embodiment only. Appropriate correction is required.

Claim 3 is objected to because of the following informalities: applicant claims another "or" phrase which is not present in the elected embodiment. Examiner contends that applicant should remove the phrase "or for taking in and supporting the insert", since examiner has properly shown that the use of the insert is another embodiment than the elected figure 1, and would result in future drawing objections if not removed. Applicant should direct all claim language the embodiment elected. Appropriate correction is required.

Claim 2 is objected to because of the following informalities: applicant claims a "possible hole present in the earlobe". Applicant should only claim structure used in the embodiment elected. Examiner notes that the piercing of the ear is only pertinent to species C, shown in figure 9. The embodiment elected does not require a hole in the earlobe, nor to know where it is. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8-9, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over patent 3459007 to Whatley, in view of patent 3266159 to Scholl.

Regarding claim 1, Whatley discloses an earring 24 having a U shaped recess (figure 3) which, with its internal width is intended for being pushed over the ear lobe 10 from below (figure 2), the said ear lobe 10 to be fitted (column 2, line 31-32). Whatley discloses that the earring is "to gently compress the lobe of the ear and engage other portions of the ear to provide frictional attachment" (column 1, line 36-40). Whatley also discloses that "it is installed on the ear merely by pressing it up and over the bottom edge of the lobe" (column 2, line 71-72). Whatley also discloses that the thickness of lobes "from one person to another will vary, the body member may be bent to form the desired width socket opening" (column 3, line 5-6).

Scholl discloses a gauge (caliper) having a mouth (between 14' and 24') with varying widths (as varying by the slide) and tongues (16 and 26) having the thickness of the respective internal width.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the caliper as taught by Scholl to adjust the earring as taught by Whatley. Whatley discloses that the earring is meant to be adjusted for size, and that each ear is sized differently. Since each earlobe is sized differently, using a known caliper, such as that taught by Scholl, will result in the ability to measure the earlobe and size the earring to the precise needed by the user. Scholl discloses that the width of the object in the channel formed between 14' and 24' will be the same width as the distance between 16' and 26'. This enables the user to take in the earlobe and to stretch out the earring to the appropriate size.

Art Unit: 3677

Whatley as modified by Scholl discloses the claimed invention except for the separately sized gauges and the separately sized earrings. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use separate gauges and earrings, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. See MPEP 2144; *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). Regarding the gauges, examiner contends that this is similar to having separate measuring cups for a quarter cup, half cup, and one cup, while a single graduated measuring cup having all the gradations to measure those volumes in one device. Both serve the same purpose in the same manner. As for the earrings, Whatley discloses that the earrings are made of metal, which, with multiple size adjustments, may become weakened by fatigue by regular bending for size purposes. Selecting the one earring that fits the user would be desirable to prevent metal fatigue in the earrings.

Examiner further notes it would have been obvious to one having ordinary skill in the art at the time the invention was made, to comprise a plurality of gauges and earrings, as it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. See also, MPEP § 2144.05 which states: *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Regarding the gauges, examiner contends that this is similar to having separate measuring cups for a quarter cup, half cup, and one cup, while a single graduated measuring cup having all the gradations to measure those volumes in one device. Both serve the same purpose in the same manner. As for the earrings,

Art Unit: 3677

Whatley discloses that the earrings are made of metal, which, with multiple size adjustments, may become weakened by fatigue by regular bending for size purposes. Selecting the one earring that fits the user would be desirable to prevent metal fatigue in the earrings.

Regarding the method of application of the earring, examiner notes that Whatley discloses that the earring compresses the earlobe slightly, to create a frictional attachment to the ear. Examiner takes Official Notice that it is a known property of parts of the human body, in particular the lip and earlobe, will decrease in width when pulled. This is based on the well known conservation of volume, in that when one dimension is elongated, the other dimensions must shorten to contain the same volume. Since this is a known property of the ear and lip, and since the earring as taught by Whatley is sized to compress the relaxed ear to a smaller width, it would have been obvious to one of ordinary skill in the art (or those wearing the earring of Whatley) to stretch the ear in order to apply the earring to the earlobe. Examiner also notes this concept is applicable to any part of the body, including extremities and the torso (compression clothing, etc...) Examiner further notes that she herself pulls on the ear to apply all types of earrings, including clip on and pierced earrings.

Regarding claim 8, Whatley as modified discloses the ear jewelry system as per claim 1, characterized in that the ear jewelry is made from a metal,(column 2, line 2) and is fitted with a decorative item.

Art Unit: 3677

Whatley as modified discloses the claimed invention except for the particular metal or the material of the decorative item. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use known jewelry metals and decorative items, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Examiner contends that any metal known in the art of jewelry would be suitable to create the body of the earring as taught by Whatley. Whatley also discloses an “ornament” 26, and a multitude of the materials, including metals, stones and other appropriately sized items would be obvious to use as decoration as known in the art.

Regarding claim 9, Whatley as modified discloses the ear jewelry system as per claim 1.

Whatley as modified discloses the claimed invention except for the particular metal or the material of the decorative item. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use known jewelry metals and decorative items, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Examiner contends that any “resilient material” known in the art of jewelry would be suitable to create the body of the earring as taught by Whatley.

Regarding claim 12, Whatley discloses an earring having a recess 40 defining an internal width (figure 3), where the earring is pushed over the ear from the bottom (figure 2). Whatley does not disclose a gauge, multiple earrings, of the stretched ear.

Scholl discloses a gauge a having a mouth (between 14 and 24) with different internal gauge widths (sliding gauge), and tongue (between 16' and 26') corresponding to the internal gauge width.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the caliper as taught by Scholl to adjust the earring as taught by Whatley. Whatley discloses that the earring is meant to be adjusted for size, and that each ear is sized differently. Since each earlobe is sized differently, using a known caliper, such as that taught by Scholl, will result in the ability to measure the earlobe and size the earring to the precise needed by the user. Scholl discloses that the width of the object in the channel formed between 14' and 24' will be the same width as the distance between 16' and 26'. This enables the user to take in the earlobe and to stretch out the earring to the appropriate size.

Whatley as modified by Scholl discloses the claimed invention except for the separately sized gauges and the separately sized earrings. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use separate gauges and earrings, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. See MPEP 2144; *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). Regarding the gauges, examiner contends that this is similar to having separate measuring cups

Art Unit: 3677

for a quarter cup, half cup, and one cup, while a single graduated measuring cup having all the gradations to measure those volumes in one device. Both serve the same purpose in the same manner. As for the earrings, Whatley discloses that the earrings are made of metal, which, with multiple size adjustments, may become weakened by fatigue by regular bending for size purposes. Selecting the one earring that fits the user would be desirable to prevent metal fatigue in the earrings.

Examiner further notes it would have been obvious to one having ordinary skill in the art at the time the invention was made, to comprise a plurality of gauges and earrings, as it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. See also, MPEP § 2144.05 which states: *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Regarding the gauges, examiner contends that this is similar to having separate measuring cups for a quarter cup, half cup, and one cup, while a single graduated measuring cup having all the gradations to measure those volumes in one device. Both serve the same purpose in the same manner. As for the earrings, Whatley discloses that the earrings are made of metal, which, with multiple size adjustments, may become weakened by fatigue by regular bending for size purposes. Selecting the one earring that fits the user would be desirable to prevent metal fatigue in the earrings.

Regarding the method of application of the earring, examiner notes that Whatley discloses that the earring compresses the earlobe slightly, to create a frictional attachment to the ear. Examiner takes Official Notice that it is a known property of parts

Art Unit: 3677

of the human body, in particular the lip and earlobe, will decrease in width when pulled. This is based on the well known conservation of volume, in that when one dimension is elongated, the other dimensions must shorten to contain the same volume. Since this is a known property of the ear and lip, and since the earring as taught by Whatley is sized to compress the relaxed ear to a smaller width, it would have been obvious to one of ordinary skill in the art (or those wearing the earring of Whatley) to stretch the ear in order to apply the earring to the earlobe. Examiner further notes that she herself pulls on the ear to apply all types of earrings, including clip on and pierced earrings.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whatley in view of 3266159 to Scholl as applied to claim 1 above, and further in view of patent 6105269 to Kondrat.

Regarding claim 2, Whatley as modified discloses the ear jewelry system as per Claim 1, characterized in that the separate gauges (the gauge taught by Scholl and separated) belonging to the system, but does not have an integral length scale.

Kondrat discloses a caliper for measuring parts of the body with a scale for length 44.

It would have been obvious to one of ordinary skill in the art to apply a measurement for length in the caliper as taught by Scholl as suggested by Kondrat. Kondrat is a known caliper for a known part of the body. Examiner contends that

Art Unit: 3677

measuring the body in any location might desire to measure the length as well as the width at the same time, which is taught by Kondrat.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whatley as modified as applied to claim 1 above, and further in view of patent 2510511 to Mittendorf.

Regarding claim 3, Whatley as modified discloses the ear jewelry system as per claim 1, characterized in that the U shaped recesses on the ear jewelry (of Whatley disclosed in figure 3), but does not disclose the inner walls having barbs.

Mittendorf discloses an earring having a frictional attachment to the ear with inner surfaces of the earring having barbs 4.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the surfaces as taught by Mittendorf to another similarly attached earring, as that taught by Whatley. Both earrings are taught to be frictionally attached with a compression of the earlobe. Since the barbs are attached in order to have "greater grip to prevent any possible slipping of the earring from the ear lobe" (column 2, line 36), Examiner contends that the barbs would be applied to the similarly structured and used earrings as taught by Whatley.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see 892.

Art Unit: 3677

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILY M. MORGAN whose telephone number is (571)270-3650. The examiner can normally be reached on Monday-Thursday, alternate Fri, 7:30am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor Batson/  
Supervisory Patent Examiner, Art Unit 3677

Emm  
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